

REMARKS

Applicants have carefully reviewed the arguments presented in the Office Action and respectfully request reconsideration of the claims in view of the remarks presented below.

Claims 1, 2, 9, 11 and 14 were amended and claims 5, 8, 12 and 15 were canceled. Thus, claims 1-4, 6-7, 9-11, 13-14 and 16-20 are pending in the application. No new matter was added by the aforementioned amendments.

Claims 1, 9, 11 and 14 were rejected under 35 U.S.C. 102(b) as being anticipated by Liu et al. (hereinafter, "Liu", US 6,760,752). Further, claims 1-7 and 9-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tomkow WIPO Publication WO 01/10090 (hereinafter "Tomkow") in view of Dickie et al. (hereinafter, "Dickie", US 6,643,687). Applicant respectfully traverses these rejections.

Claim 1 was amended to recite generating a manually initiated reply to a message at a recipient, the manually initiated reply including a request from the recipient to receive proof of transmission or delivery of the manually initiated reply to the sender, and also that the server transmits the manually initiated reply to the sender in a manner wherein the server receives an indication that the reply is transmitted or delivered to the sender and then transmits the indication that the reply is transmitted or delivered to the sender to the recipient. None of the cited art teaches or even suggests such elements.

Tomkow discloses only receiving Delivery Status Notifications (DSNs) that are returned to the server by the Mail Transfer Agent (MTA) or Mail User Agent (MUA) of the recipient. Those skilled in the art know that DSNs are automatically generated by a recipient's email system if the system provides for their support. Applicant claims a reply that is manually initiated by the recipient of the email, which is completely different from an automatic DSN generated by a recipients email system.

Moreover, Dickie does not provide such a manually initiated reply, disclosing only a system that is capable of transmitting a reply from a recipient to a sender using a supplied proxy email address. Neither Dickey nor Tomkow disclose a manually initiated reply that includes a request from the recipient to the server to receive proof of transmission or delivery of the reply to the sender. Further, neither Dickey nor Tomkow, taken alone or in combination, teach or even suggest transmitting the manually uninitiated reply by the server to the sender wherein the server

receives an indication that the reply is transmitted or delivered to the sender, and then transmitting the indication to the recipient, as is claimed in amended claim 1.

Applicant further submits that claim 1 is not anticipated by Liu for the same reasons stated above. The only mention of a reply in Liu is the depiction in Figure 9 and the accompanying specification at col. 27, ll. 38-45. Liu also discloses a process for requesting a return receipt. While the disclosed process does teach a manually initiated reply to the extent that the recipient may be given the choice of whether or not to send a return receipt to the sender, the option to send such a receipt is generated from instructions provided by the sender to the server which then transmits a message including a flag to the recipient's email viewer which recognizes the flag and then presents the recipient with the choice sending the return receipt or not. The certified mail system disclosed by Liu works similarly.

Applicant's amended claim 1 claims a method wherein the sender does not have to include instructions to obtain a return receipt. Tomkow's server automatically adds instructions to a sender's message to instruct a recipient's email system to transmit a DSN notice back to the server, but does not, as acknowledged by the Examiner, disclose a reply that does not originate on the server. Nor does Dickie teach or suggest any specifics beyond a general ability to reply to an email.

Tomkow teaches a read receipt which is passed through the server by changing header information. See, Tomkow, page 25, ll. 25-33, page 15, ll. 1-13. A read receipt is an email sent to the author of a message by the recipient's Mail User Agent (MUA) or Mail Transfer Agent (MTA) when certain events occur (Tomkow, page 13, ll. 20-21) and is consequently system generated. A reply is a new message initiated by the manual actions of a recipient and sent to the original sender by the recipient. Furthermore, a read receipt, unlike a reply, does not include instructions to the server to obtain proof of transmission, delivery or content of the reply that is transmitted to the sender and, when such information is received by the server, sent to the recipient of the original message. A read receipt provides only that the original message from the sender was received by the recipient's email system. (Tomkow, page 25, lines 22-30.) Therefore, a read receipt cannot be a reply in the sense that term is used in amended claim 1, and all other claims in the application.

The method of amended claim 1 instead provides for a reply from a recipient that contains instructions from the recipient to the server to send the email in such a manner that server automatically receives proof of transmission or delivery of the reply from the original sender of the message, and then transmits that proof to the recipient. This is not same as the recipient deciding to send a return receipt to a sender, nor is the sender given a request to provide a return receipt to the recipient; it is the recipient that controls the return of the proof of delivery or transmission based upon the instructions provided by the recipient in the recipient's reply, as is claimed in amended claim 1.

Contrast this to the method described in Liu, where the sender tries to control the process by including a request for a return receipt in his message, but whether the receipt is returned is at the option of the recipient. See, Liu, col. 31, ll. 8-20. Even where the sender requests certified mail the control of the response still lies with the recipient, because the recipient can decide to reject the certified mail. Id. at col. 31, ll. 46-50. Accordingly, Applicant respectfully submits that amended claim 1, and the claims dependent therefrom, are patentable over the cited art and requests that the rejections be withdrawn and the claims allowed.

Claim 9 was amended similarly to claim 1, and now recites initiating manually a reply to the message by the recipient, the reply including a request from the recipient to receive proof of delivery of the reply to the sender and proof of content of the reply, the reply also including the unique identification and transmitting to the sender through the server the reply by the recipient to the sender in a manner wherein the server receives an indication that the reply is delivered to the sender and proof of the content of the reply, and transmitting to the recipient the indication that the reply is delivered to the sender and proof of the content of the reply. As stated with regard to similar amendments made in amended claim 1, none of the art cited, alone or in combination teaches or even suggests such a combination of steps.

Similarly to claim 1, even if all of the cited art were combined, one skilled in the art would still lack a method including the steps initiating manually a reply to the message by the recipient, the reply including a request from the recipient to receive proof of delivery of the reply to the sender and proof of content of the reply, the reply also including the unique identification and transmitting to the sender through the server the reply by the recipient to the sender in a manner wherein the server receives an indication that the reply is delivered to the sender and proof of the content of the reply, and transmitting to the recipient the indication that the reply is

delivered to the sender and proof of the content of the reply, as is claimed amended claim 9. Moreover, the cited art does not provide any motivation or suggestion that common sense or common knowledge within the art would provide the missing steps. Accordingly, Applicant believes that the claims 9 and 10 are patentable over the cited art and request that the rejections be withdrawn and the claims allowed.

Claim 11 was amended in a manner similar to claims 1 and 9. Claim 11 now recites providing for a reply from the recipient to the message from the sender through the fictional address of the sender in the database, the reply including instructions from the recipient to the server to obtain poof of the delivery of the reply to the sender and proof of content of the reply delivered to the sender, transmitting the reply to the sender through the server, receiving the reply at the server, recovering the true address of the sender from the fictional address of the sender in the database, and transmitting the reply through the server to the true address of the sender in a manner wherein the server receives an indication that the reply is delivered and proof of the content of the reply that was delivered to the sender, and, transmitting by the server to the recipient the indication that the reply was delivered and proof of the content of the reply that was delivered to the sender. As stated previously, none of the cited art teaches or even suggests such a combination of steps.

Even if all of the cited art were combined, one skilled in the art would still lack a method including the steps of providing for a reply from the recipient to the message from the sender through the fictional address of the sender in the database, the reply including instructions from the recipient to the server to obtain poof of the delivery of the reply to the sender and proof of content of the reply delivered to the sender and transmitting the reply through the server to the true address of the sender in a manner wherein the server receives an indication that the reply is delivered and proof of the content of the reply that was delivered to the sender, and, transmitting by the server to the recipient the indication that the reply was delivered and proof of the content of the reply that was delivered to the sender, as is claimed in amended claim 11. Moreover, the cited art does not provide any motivation or suggestion that common sense or common knowledge within the art would provide the missing steps. Accordingly, Applicant believes that the claim 11 and the claims dependent therefrom are patentable over the cited art and request that the rejections be withdrawn and the claims allowed.

Claim 14 was amended similarly to claims 1, 9 and 11. Claim 14 now includes receiving a reply from the recipient to the server with the unique identification of the message, the reply including instructions added by the recipient to the server for the server to supply to the recipient proof of delivery of the delivery of the reply to the sender and to confirm the content of the reply that was delivered to the sender, and sending the reply to the sender in a manner wherein the server receives an indication that the reply is delivered to the sender and confirmation of the content of the reply that was delivered to the sender, and transmitting a delivery receipt and proof of content of the reply delivered to the sender to the recipient. As stated previously, none of the cited art teaches or even suggests such a combination of steps.

Even if all of the cited art were combined, one skilled in the art would still lack a method including the steps of receiving a reply from the recipient to the server with the unique identification of the message, the reply including instructions added by the recipient to the server for the server to supply to the recipient proof of delivery of the delivery of the reply to the sender and to confirm the content of the reply that was delivered to the sender, and sending the reply to the sender in a manner wherein the server receives an indication that the reply is delivered to the sender and confirmation of the content of the reply that was delivered to the sender, and transmitting a delivery receipt and proof of content of the reply delivered to the sender to the recipient, as is claimed in amended claim 14. Moreover, the cited art does not provide any motivation or suggestion that common sense or common knowledge within the art would provide the missing steps. Accordingly, Applicant believes that the claim 14 and the claims dependent therefrom are patentable over the cited art and request that the rejections be withdrawn and the claims allowed.

CONCLUSION

Applicant has carefully reviewed the arguments presented in the Office Action and respectfully requests reconsideration of the claims in view of the remarks presented. In light of the above amendments and remarks, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Should the Examiner have any questions concerning the above amendments and arguments, or any suggestions for further amending the claims to obtain allowance, Applicant requests that the Examiner contact Applicant's attorney, John Fitzgerald, at 310-242-2667.

The Commissioner is authorized to credit any overpayment or charge any additional fees in this matter to our Deposit Account No. 06-2425.

Date: January 12, 2009

Respectfully submitted,

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